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10/723,228	11/26/2003	Hiroko Ohishi	17275	9157
23389 7590 01/18/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
RAJ, RAJIV J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



**Office Action Summary****Application No.**

10/723,228

**Applicant(s)**

OHISHI, HIROKO

**Examiner**

RAJIV J. RAJ

**Art Unit**

4143

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/IB)
- Paper No(s)/Mail Date 26 November 2003 10 May 2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 26 November 2003.
2. Claims 1-18 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statements filed 26 November 2003 and 10 May 2006 have been considered. An initialed copy of the Form 1449 is enclosed herewith.

### **Priority**

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. JP2002-345814 filed on 28 November 2002.

### **Claim Rejections - 35 USC § 101**

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The matter in claim 12, *a computer-readable storage medium on which is recorded a program for causing a computer to execute a process*, is merely an abstract idea, and therefore only a judicial exception and not a recognized statutory category. The preamble in claim 12 should read, *a recorded program for causing a computer to execute a process tangibly embodied on a computer-readable storage medium*, in order to be in compliance with 35 U.S.C. 101.



Art Unit: 4143

7. Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The matter in claim 16, *computer data signal*, is merely an abstract idea, and therefore only a judicial exception and not a recognized statutory category. The preamble in claim 16 should read, *a recorded program for causing a computer to execute a process tangibly embodied on a computer-readable storage medium*, in order to be in compliance with 35 U.S.C. 101.

### Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldstein (US 200100021910) (hereinafter Goldstein).

**As per claim 1**, Goldstein teaches a system assisting in services rendered in a medical institution, the system including:

- *a preprocedure information inputting unit inputting preprocedure information which is composed of at least one of a type of a drug used for a preprocedure performed before an examination is conducted, an amount of the drug, an appliance used for the preprocedure, and a name of a person who performs the preprocedure* (see at least Goldstein [0057] "As information is obtained from patient prospects and patients, and from the medical practitioner's office, it may be entered into and retrieved from the system through various forms of input/output devices operatively connected to the main processing unit 10 and each of the remote CPUs 16")
- *a condition inputting unit inputting patient condition information, which is information indicating a condition of a patient after the preprocedure;* (see at least Goldstein [0057])



- *a storing unit correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure. (see at least Goldstein [0054] "in a preferred embodiment includes, at the system representation end, a main processing unit 10 with data storage capability,")*

**As per claim 2**, Goldstein, as shown, discloses the following limitation:

- *a correlated information presenting unit presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored in the storing unit. (see at least Goldstein [0046] "means for scheduling and coordinating pre and post-operative medical appointments and procedures between patients and medical practitioners; means for receiving, processing and delivering pre and post procedure care orders and medicament prescriptions from medical practitioners to patients;" )*

**As per claim 3**, Goldstein, as shown, discloses the following limitation:

- *an examination reservation displaying unit displaying examination reservation information, which is reservation information of the examination; (see at least Goldstein Fig.1 Item:17 and [0046] "the system provide clear, concise information about the available procedures and options, including information regarding the selected medical practitioner's appointment times, including the patient's scheduled appointments and a description of what will take place and which staff members will be involved,")*
- *a display controlling unit controlling a display form of the examination reservation information displayed on the examination reservation displaying unit, based on the patient condition information. (see at least Goldstein Fig.1 Item:17 and [0061] "Patient histories and current conditions are collected by accessing a series of screens")*

**As per claim 6**, Goldstein, as shown, discloses the following limitation:

- *the display controlling unit displays predetermined information possessed by patient condition information corresponding to predetermined examination reservation information if only the predetermined examination reservation information is selected from among the examination reservation information displayed on the examination reservation displaying unit, based on*



Art Unit: 4143

*the patient condition information* (see at least Goldstein Fig.1 Item:17 and [0061] "Patient histories and current conditions are collected by accessing a series of screens providing a comprehensive selection of medical facts on allergies, past medical history, family history, social history and a comprehensive review of systems which can be easily selected to indicate positive responses and, where appropriate, pertinent negative responses.")

**As per claim 7**, Goldstein, as shown, discloses the following limitation:

- *marking for the examination reservation information* (see at least Goldstein [0024] "a patient profile that is used by the medical practitioner as a continually updated patient record to identify patient psychological and other medical needs as well as their need for procedure . . . The system also generates patient specific pre and post operative care information and product kits and provides means for tracking patient.")
- *displayed on the examination reservation displaying unit in color.* (see at least Goldstein Fig.1 Item:17)

**As per claim 8**, Goldstein, as shown, discloses the following limitation:

- *a history information displaying unit displaying a history of the patient condition* (see at least Goldstein [0061])
- *information stored in the storing unit* (see at least Goldstein [0071] "The system contains hardware and software components to capture 26 and store 30")

### Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US 200100021910) (hereinafter Goldstein) in view of Edelson et al. (US 5,737,539) (hereinafter Edelson).

#### **Claim 4**

Goldstein, discloses the limitations of Claim 1. Goldstein does not disclose the following limitations, however Edelson, as shown does:

*the preprocedure information inputting unit is a portable terminal.* (see at least Edelson Column:7 Lines: 43-48) "The prescription management system shown in this embodiment of the invention has been designed for implementation on physically compact, portable, user-interface devices such as small portable personal computers, especially hand held devices known as personal digital assistants.")

#### **Claim 5**

Goldstein, discloses the limitations of Claim 1. Goldstein does not disclose the following limitations, however Edelson, as shown does:

- *preprocedure information inputting unit is a portable reading device.* (see at least Edelson Column:7 Lines: 43-48 and 3 Read in view of the applicants specification, (Ohishi [0030]) which states that "a PDA (Personal Digital Assistant) may be available as the portable reading device.")



13. Claims 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US 200100021910) (hereinafter Goldstein) in view of Jeacock et al. (US 6014630) (hereinafter Jeacock).

**Claim 9**

**Goldstein as shown, discloses the following limitations:**

- *inputting patient condition information, which is information indicating a condition of a patient after the preprocedure; (see at least Goldstein [0057])*
- *correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure. (see at least Goldstein [0054])*

Goldstein does not disclose the following limitations, however Jeacock, as shown does:

- *inputting preprocedure information which is composed of at least one of a type of a drug used for a preprocedure performed before an examination is conducted, an amount of the drug, an*
- *appliance used for the preprocedure, and a name of a person who performs the preprocedure (see at least Jeacock Column 3 Lines: 20-25 & 31-34 "A typical individualized patient document would include: (a) The name of the procedure to be undertaken. (b) The patient's and doctor's names, with necessary telephone numbers. (c) Tests which must be performed in advance, giving times and locations. (f) Type of anesthesia to be used, its effects, and the length of the procedure. (g) Information as to after effects, discomfort, healing time, and post-procedure medications.)*

With regards to the limitation using *an appliance used for the preprocedure*, Jeacock does not specifically disclose the use of *an appliance*. However, Jeacock does disclose a "Type of anesthesia to be used", and therefore it would have been obvious to one skilled in the art at the time of the invention that the administration of anesthesia requires the use of *an appliance*.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the *inputting patient condition information* and the *correlating and storing unit*, as taught by Goldstein, with the *preprocedure inputting preprocedure information*, as disclosed in Jeacock, with the motivation providing more effective medical procedures.



**Claim 10**

The combination of Goldstein/Jeacock discloses all of the limitations of claim 9. Goldstein further discloses the following limitation:

- *presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored.* (see at least Goldstein [0046])

**Claim 11**

The combination of Goldstein/Jeacock discloses all of the limitations of claim 9. Goldstein further discloses the following limitation:

- *displaying examination reservation information, which is reservation information of the examination;* (see at least Goldstein Fig.1 Item:17 and [0046])
- *and controlling a display form of the displayed examination reservation information, based on the patient condition information.* (see at least Goldstein Fig.1 Item:17 and [0061])

**Claim 12**

**Goldstein as shown, discloses the following limitations:**

- *inputting patient condition information, which is information indicating a condition of a patient after the preprocedure;* (see at least Goldstein [0057])
- *correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure.* (see at least Goldstein [0054])

Goldstein does not disclose the following limitations, however Jeacock, as shown does

- *inputting preprocedure information which is composed of at least one of a type of a drug used for a preprocedure performed before an examination is conducted, an amount of the drug, an appliance used for the preprocedure, and a name of a person who performs the preprocedure* (see at least Jeacock Column 3 Lines: 20-25 & 31-34)

With regards to the limitation using *an appliance used for the preprocedure*, Jeacock does not specifically disclose the use of *an appliance*. However, Jeacock does disclose a "Type of anesthesia



Art Unit: 4143

to be used", and therefor it would have been obvious to one skilled in the art at the time of the invention that the administration of anesthesia requires the use of *an appliance*.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the *inputting patient condition information* and the *correlating and storing unit*, as taught by Goldstein, with the *preprocedure inputting preprocedure information*, as disclosed in Jeacock, with the motivation providing more effective medical procedures.

**Claim 13**

The combination of Goldstein/Jeacock discloses all of the limitations of claim 12. Goldstein further discloses the following limitation:

- *presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored.* (see at least Goldstein [0046])

**Claim 14**

The combination of Goldstein/Jeacock discloses all of the limitations of claim 12. Goldstein further discloses the following limitation:

- *displaying examination reservation information, which is reservation information of the examination;* (see at least Goldstein Fig.1 Item:17 and [0046])
- *and controlling a display form of the displayed examination reservation information, based on the patient condition information.* (see at least Goldstein Fig.1 Item:17 and [0061])

**Claim 15**

**Goldstein as shown, discloses the following limitations:**

- *inputting patient condition information, which is information indicating a condition of a patient after the preprocedure;* (see at least Goldstein [0057])
- *correlating and storing the preprocedure information, the patient condition information, and a time of the preprocedure.* (see at least Goldstein [0054])

Goldstein does not disclose the following limitations, however Jeacock, as shown does

- *inputting preprocedure information which is composed of at least one of a type of a drug used for a preprocedure performed before an examination is conducted, an amount of the drug, an*



*appliance used for the preprocedure, and a name of a person who performs the preprocedure* (see at least Jeacock Column 3 Lines: 20-25 & 31-34)

With regards to the limitation using *an appliance used for the preprocedure*, Jeacock does not specifically disclose the use of *an appliance*. However, Jeacock does disclose a "Type of anesthesia to be used", and therefor it would have been obvious to one skilled in the art at the time of the invention that the administration of anesthesia requires the use of *an appliance*.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the *inputting patient condition information* and the *correlating and storing unit*, as taught by Goldstein, with the *preprocedure inputting preprocedure information*, as disclosed in Jeacock, with the motivation providing more effective medical procedures.

#### **Claim 16**

The combination of Goldstein/Jeacock discloses all of the limitations of claim 15. Goldstein further discloses the following limitation:

- *presenting a correlation among the preprocedure information, the patient condition information, and the time of the preprocedure, which are stored.* (see at least Goldstein [0046])

#### **Claim 17**

The combination of Goldstein/Jeacock discloses all of the limitations of claim 15. Goldstein further discloses the following limitation:

- *displaying examination reservation information, which is reservation information of the examination;* (see at least Goldstein Fig.1 Item:17 and [0046])
- *and controlling a display form of the displayed examination reservation information, based on the patient condition information.* (see at least Goldstein Fig.1 Item:17 and [0061])



**Claim 18**

**Goldstein as shown, discloses the following limitations:**

- *condition inputting means for inputting patient condition information, which is information indicating a condition of a patient after the preprocedure; (see at least Goldstein [0057])*
- *storing means for correlating and storing the preprocedure information, the. patient condition information, and a time of the preprocedure. (see at least Goldstein [0054])*

Goldstein does not disclose the following limitations, however Jeacock, as shown does

- *preprocedure information inputting means for inputting preprocedure information which is composed of at least one of a type of a drug used for a preprocedure performed before an examination is conducted, an amount of the drug, an appliance used for the preprocedure, and a name of a person who performs the preprocedure; (see at least Jeacock Column 3 Lines: 20-25 & 31-34)*

With regards to the limitation using *an appliance used for the preprocedure*, Jeacock does not specifically disclose the use of *an appliance*. However, Jeacock does disclose a "Type of anesthesia to be used", and therefore it would have been obvious to one skilled in the art at the time of the invention that the administration of anesthesia requires the use of *an appliance*.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the *inputting patient condition information* and the *correlating and storing unit*, as taught by Goldstein, with the *preprocedure inputting preprocedure information*, as disclosed in Jeacock, with the motivation providing more effective medical procedures.

***Conclusion***

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **571-270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571.272.6710**.



Art Unit: 4143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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Date: 1/07/08  
/Rajiv J Raj/ Patent Examiner Art Unit 4143

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